

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **MOREH et al.**

For (title): **FEDERATED AUTHENTICATION SERVICE**

Filing Date: **04/07/2001**

Serial No: **09/827,697**

Examiner: **SHEIKH, Ayaz**

Art Unit: **2155**



Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313

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REQUEST FOR RECONSIDERATION OF PETITION TO MAKE SPECIAL
OR
RENEWED PETITION TO MAKE SPECIAL
37 C.F.R. 1.102 and MPEP § 708.02(VIII)

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OCT 09 2003

Technology Center 2100

Sir:

1. Petition (MPEP § 708.02(VIII)(A))

Applicant hereby requests reconsideration of its petition to make special of June 20, 2003. This petition was held dismissed in a decision on petition mailed Aug. 29, 2003 (paper 8). The reasons stated for the dismissal were failure to state that the references submitted were those deemed most closely related to the subject matter and failure to provide a detailed discussion of the references that points out with particularity how the claimed subject matter is patentable over the references. We urge that these deficiencies are corrected herein.

In the alternative, Applicant hereby requests that this be treated as renewed petition to make special.

This new application has not received any examination by the Examiner.

2. Claims (MPEP § 708.02(VIII)(B))

All of the claims in this case are directed to a single invention. If the Office determines that all of the claims presented are not directed to a single invention, then applicant will make an election without traverse as a prerequisite to the grant of special status.

3. Search (MPEP § 708.02(VIII)(C))

We have made or caused to be made a careful and thorough search of the prior art. This case is the parent of Int. App. No. PCT/US02/08796. In prosecution of the child case under the Patent Cooperation Treaty (PCT) an International Search Report (ISR) was prepared by the Office acting in its capacity as an International Search Authority (ISA/US) and an International Preliminary Examination Report (IPER) was prepared by the Office, acting in its capacity as an International Preliminary Examination Authority (IPEA/US). Since both cases corresponding exactly in the subject matter and claims, we submit that the ISR and IPER have applicability in both cases.

The ISR indicates that that U.S. classifications 709/229, 202, 217 were searched. The West and STN databases were used, searching with the key words “authentication,” “agent,” “client,” “proxy,” and “server application.” Both the ISR and the IPER were prepared under the direction of PCT Authorized Officer Ayaz R. Sheikh, who has many years of experience and continues as an Examiner in the United States Patent and Trademark Office.

Copies of the ISR and IPER are enclosed.

4. Copies (MPEP § 708.02(VIII)(D))

Submitted herewith are copies of each of the references deemed most closely related to the subject matter encompassed by the claims.

5. Discussion (MPEP § 708.02(VIII)(E))

There is submitted herewith a detailed discussion of the references, which discussion particularly points out how the claimed subject matter is distinguishable over the references.

6. Fee (MPEP § 708.02(VIII)(A))

Applicant paid a petition fee in its petition to make special of June 20, 2003. If that fee is found to be non-applicable or deficient, the Office is hereby authorized to charge any additional fees required or to credit any overpayments to deposit account **08-3240**.

A duplicate copy of this petition is enclosed for billing purposes.

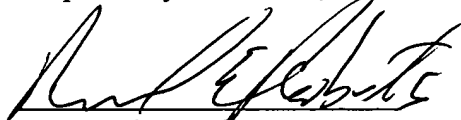
CONCLUSION

We respectfully urge that all requirements for a petition to make special in this case have now been complied with and we request that this petition be granted.

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**DETAILED DISCUSSION OF REFERENCES IN SUPPORT OF THE
ACCOMPANYING PETITION TO MAKE SPECIAL**

Sir:

The PCT ISR cites four references, two of which we deem to be the references most closely related to the subject matter encompassed by the claims.

The ISR indicates that U.S. Pat. No. 6,134,658 by MULTERER et al. and U.S. Pat. No. 6,092,199 by DUTCHER et al. are "A" category documents (a "*document defining the general state of the art which is not considered to be of particular relevance*"). Applicant agrees, and has concluded that these references are not closely enough related to the present case to merit discussion here.

In contrast, the ISR lists U.S. Pat. No. 6,324,648 by GRANTGES Jr., issuing 27 Nov. 2001 (hereinafter Grantges), and U.S. Pat. No. 6,219,790 by LLOYD et al., issuing 17 Apr. 2001 (hereinafter Lloyd) as documents in both the "Y" and "P" categories. A "Y" category document is a "*document of particular relevance: the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.*" A "P" category document is a "*document published prior to the international filing date but later than the priority date claimed.*"

We respectfully disagree with the PCT finding in the ISR that the claimed invention is obvious in view of Grantges and Lloyd. Furthermore, we note that the Authorized Officer necessarily had to have concluded otherwise when performing the examination, since the same Officer handled the international search and examination and the IPER is entirely favorable for patentability.

The claimed subject matter is distinguishable over the Grantges and Lloyd references in at least the following respects.

The present application includes two independent claims, claims 1 and 23. Turning first to claim 1 (as amended in the preliminary amendment), it recites:

1. A system for authenticating a subject residing in a subject domain on a network to a server application residing in a server domain on the network, wherein an authentication mechanism residing in an authentication domain on the network affects the service provided by the server application, the system comprising:

- a client for communicating with other components of the system and for authenticating the subject to other components of the system by providing client credentials on behalf of the subject, wherein said client also resides in the subject domain; and
- a protocol proxy for communicating between said client and the authentication mechanism and for authenticating said client based on said client credentials, for obtaining from the authentication mechanism temporary credentials for said client to access the server application, and for creating from said temporary credentials an authentication name assertion allowing said client to access the server application.

However, neither Grantges or Lloyd, or their combination, teaches or reasonably suggests a protocol proxy (we discuss the client below). Reference to FIG. 1 of the application will help to follow this. Applicant's protocol proxy communicates between a client in a subject domain (i.e., a user seeking to ultimately be authenticated to a server application in a server domain) and an authentication mechanism in an authentication domain. The authentication mechanism provides, back to the client, temporary credentials for the client to then access the server application.

Grantges teaches "*A demilitarized zone (DMZ) proxy server [that] intercepts messages destined for the destination servers*" (abstract). This is distinguishable because Applicant's protocol proxy does not intercepts messages destined for the server application or the server domain. In fact, Applicant's protocol proxy never need communicate with anything in the server domain. The whole point of the claimed invention is to provide the client credentials the server domain will trust enough to let the client and server application communicate directly.

With respect to Grantges, the ISR cites its Abstract; Figs. 1, 6-7; and "*Col. 57 [SIC; Col. 12, Line 57] to col. 14, Line 24*" as being relevant to claims 1-42. However, nothing here, or anywhere that we can find in this reference, contradicts our rationale that Grantges teaches user-proxy-destination communication and the claimed invention is for user-proxy communication to obtain credentials and then user-destination communication wherein the destination accepts the

credentials. Grantges also teaches a special cookie, but rather than act as credentials, this cookie is used for end application selection and routing to the end applications.

Turning now to Lloyd, it teaches an Authentication, Authorization and Accounting server (AAA server) that is interposed between users and a standard database management system (DBMS) that stores user AAA-type data. The AAA server controls access to that data, and that data can include the address of a proxy system which may even be another AAA server (FIG. 5). However, Lloyd clearly is teaching user-AAA server-destination communication (see e.g., FIG. 1), and thus, Applicant's claim 1 is again distinguishable here as well.

With respect to the Lloyd, ISR cites its Abstract; Col. 2, Line 48 to Col. 3, Line 45; and Col. 4, Line 23 to Col. 6, Line 32 as being relevant to claims 1-42. However, nothing here, or anywhere that we can find in this reference, contradicts our rationale that Lloyd teaches elements for routing communication differently than the claimed invention.

Turning now to Applicant's client, we note that neither Grantges or Lloyd, or their combination, teaches or reasonably suggests such a client. Applicant's client authenticates the subject by providing client credentials received from the protocol proxy. As already noted, Grantges teaches a cookie used for end application selection and routing to the end applications. This cookie therefore is not equivalent to the client credentials used by Applicant's client. The clients taught by Lloyd use standard software modules, with a major point of novelty in Lloyd being that its AAA server permits this by being able communicate with the standard software modules regardless of the multiplicity of standard security protocols they may use. Furthermore, Lloyd nowhere teaches anything equivalent to Applicant's client credentials.

In sum, neither Grantges or Lloyd, or their combination, teaches or reasonably suggests the client or the protocol proxy of the claimed invention.

Turning now to claim 23, it recites:

23. A method for authenticating a subject residing in a subject domain on a network to a server application residing in a server domain on the network, wherein an authentication mechanism residing in an authentication domain on the network affects the service provided by the server application, the method comprising the steps:

- (a) authenticating the subject to a protocol proxy with a client by providing subject credentials on behalf of the subject;
- (b) obtaining a name assertion from said protocol proxy via the authentication mechanism which will allow said client to access the server application, thereby mediating between said protocol proxy and the authentication mechanism to permit the subject to access the server application via said client;

- (c) creating an authentication name assertion with said protocol proxy based on said subject credentials which will allow said client to access the server application;
- (d) communicating said authentication name assertion to said client; and
- (e) communicating said authentication name assertion to the server application.

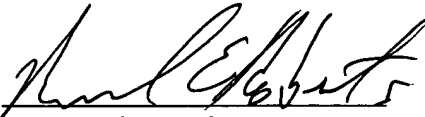
And this is basically a method working with many of the same elements as claim 1. In particular, claim 23 also includes a client and a protocol proxy. These here work with an authentication name assertion, but for applicable purpose this is equivalent to the client credentials of claim 1. Accordingly, claim 23 is distinguishable over Grantges or Lloyd for the same reasons that claim 1 is.

In sum, neither Grantges or Lloyd, or their combination, teaches or reasonably suggests the client or the protocol proxy of the claimed invention. Accordingly, we respectfully ask for favorable consideration of the petition to make special.

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